

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 2, 4-10, 12-14, and 16 are currently pending in this application, Claims 1, 7, 8, and 16 having been amended without the introduction of new matter.

In the outstanding Office Action, Claims 1, 4 and 5 were objected to; Claims 1, 4, 5, 7, 9, 12, and 13 were rejected under 35 U.S.C. §103(a) as anticipated by Iwama et al. (JP 11-24507, hereinafter Iwama) in view of Kawaguchi et al. (JP 2002-251078a, hereinafter Kawaguchi); Claims 8 and 16 were rejected under 35 U.S.C. §103(a) as unpatentable over Morikoshi et al. (JP 4-333457, hereinafter Morikoshi) in view of Kawaguchi; and Claims 2, 6, 10, and 14 were allowed.

Applicant acknowledges with appreciation the indication of allowable subject matter.

With respect to the objection to Claim 1 (and Claims 4 and 5 dependent thereon), Claim 1 is amended to correct the informality identified in the outstanding Office Action. Thus, Applicant respectfully requests that the objection to Claims 1, 4, and 5 be withdrawn. Furthermore, Claim 7 is amended to correct a similar informality.

With respect to the rejection of Claim 1 as unpatentable over Iwama and Kawaguchi, Applicant respectfully traverses this ground of rejection. Claim 1 recites, *inter alia*, “wherein the Young’s modulus of the belt is in a range of 3000 megapascals to 7000 megapascals.”

The outstanding Office Action states ‘Iwama et al. does not teach the Young’s modulus of the belt.’¹ Furthermore, Applicants respectfully submit that Kawaguchi does not cure the admitted deficiency in Iwama.

The outstanding Office Action takes the position that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to select the appropriate

¹ Office Action, page 3.

Young's modulus for the belt.² Applicants respectfully traverse this position because the only indication that the belt should have a Young's modulus in the claimed range is in Applicant's specification and cannot be used as "prior art."

Furthermore, the specification states

As the Young's modulus of the intermediate transfer belt 10 used in the present embodiment varies in the range of 3000 megapascals to 7000 megapascals according to the material, there is no possibility of occurrence of color shift. The range of the Young's modulus of the intermediate transfer belt 10 also varies according to the tension T applied, the maximum length L of the image formed, and the fluctuation in the Young's modulus α , etc. Whatever the case, it is preferable to choose these settings in order that the color shift on the image is never greater than 0.03 millimeters.³ [Emphasis added].

The claimed "wherein the Young's modulus of the belt is in a range of 3000 megapascals to 7000 megapascals" is an improvement in a belt, which in non-limiting embodiments is used in an image forming apparatus, directed toward solving the above-noted problem of color shift.

It is well established that when particular claimed features are disclosed as solving particular problems and providing advantages, as in the present specification, the doctrine of design choice cannot be relied upon as a substitute for a clear and convincing showing of motivation that would logically have led the artisan to have made the proposed modification.

See In re Chu, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

The above-noted benefit resulting from the claimed "wherein the Young's modulus of the belt is in a range of 3000 megapascals to 7000 megapascals" shows that it would not be an obvious design choice for a person of ordinary skill in the art to select a Young's modulus for the belt in the claimed range.

² Office Action, page 3.

³ Specification, page 18, lines 15-18.

Furthermore, the Office Action fails to identify concrete evidence to support the conclusion that “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to select the appropriate Young’s modulus.”⁴

In this regard, it is noted that substitution of an improper subjective conclusion as to knowledge in the art for concrete evidence of such knowledge relative to a core factual finding required for a determination of patentability is clearly improper. See In re Zurko, 59 USPQ2d 1693, 1697-98 (Fed. Cir. 2001) as follows:

Finally, the deficiencies of the cited references cannot be remedied by the [PTO’s] general conclusions about what is “basic knowledge” or “common sense” to one of ordinary skill in the art. As described above, the [PTO] contended that even if the cited UNIX and FILER2 references did not disclose a trusted path, “it is basic knowledge that communication in trusted environments is performed over trusted paths” and, moreover, verifying the trusted command in UNIX over a trusted path is “nothing more than good common sense.” *Ex parte Zurko*, slip op. at 8. We cannot accept these findings by the [PTO]. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the [PTO] clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the [PTO] cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the [PTO] must point to some concrete evidence in the record in support of these findings. [Emphasis added.]

The even more recent Lee decision by the Federal Circuit Court of Appeals (In re Lee, 61 USPQ2d, 1430, 1435 (2002)) is again noted to emphasize the need for the PTO to provide actual evidence on the record, not mere unsupported opinion, as follows:

In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the

⁴ Office Action page 3.

art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. [Emphasis added.]

The Lee court further specifically found it to be erroneous and arbitrary conduct for the PTO to attempt to resolve questions material to patentability by reliance upon “subjective belief and unknown authority” (see In re Lee at 61 USPQ2d 1434) as is being done here. Also note the Kotzab court admonition (at 55 USPQ2d 1317) that “[b]road conclusory statements are not evidence.”

Furthermore, the response filed on March 23, 2006 traversed the Examiner’s use of Official Notice. However, the outstanding Office Action does not provide a reference to support the use of Official Notice. As set forth in MPEP §2144.03, if an Applicant traverses an assertion made by an Examiner while taking official notice, the Examiner should cite a reference in support of their assertion. Although the outstanding Office Action states “Iwama et al. teaches a reflecting scale in figure 1,”⁵ the outstanding Office Action still provides no evidentiary support for the position “that it is well known in the art to use a scale having magnetic and non-magnetic portions as a part of a speed detecting system for a belt.”⁶ Again, Applicant respectfully traverses this position. Applicant does not consider the feature for which Official Notice was taken to be “of such notorious character that Official Notice can be taken.”

In view of above discussion, Applicants respectfully submit that Claim 1 (and Claims 3, 4, and 5) patentably distinguish over Iwama and Kawaguchi. Claim 7 is similar to Claim 1. Thus, Applicants respectfully submit that Claim 7 patentably distinguishes over Iwama and Kawaguchi for at least the reasons stated for Claim 1.

With respect to the rejection of Claims 8 and 16 as unpatentable over Morikoshi and

⁵ Office Action, page 4.

⁶ Office Action, page 2.

Kawaguchi, Applicants respectfully submits that the amendment to Claims 8 and 16 overcomes this ground of rejection. Amended Claims 8 and 16 recite, *inter alia*, “the Young’s modulus of the belt is in a range of 3000 megapascals to 7000 megapascals.”

Morikoshi and Kawaguchi do not disclose or suggest the claimed range for the Young’s modulus of the belt.

Furthermore, the advantageous of the claimed range of the Young’s modulus for the belt was explained above.

Thus, Applicant respectfully submits that amended Claims 8 and 16 patentably distinguish over Morikoshi and Kawaguchi, taken alone or in proper combination.

With respect to the rejection of Claim 9, Applicant notes that the outstanding Office Action does not specifically address Claim 9. Claim 9 recites, *inter alia*, “a timing control unit that controls a start timing of an image forming operation based on a result of reading of the reading unit.”

The outstanding Office Action relies on Iwama and Kawaguchi in the rejection of Claim 9. However, the outstanding Office Action does not cite to any section in Iwama and Kawaguchi as disclosing the above-noted element of Claim 9. Moreover, **for the second time**, the outstanding Office Action fails to even address the above-noted element of Claim 9. Thus, the outstanding Office Action has not established a *prima facie* case of obviousness, and it is respectfully submitted that Claim 9 (and all claims dependent thereon) patentably distinguishes over Iwama and Kawaguchi for the reasons stated in the response filed on March 23, 2006.

Applicant respectfully points out that MPEP §707.07(f) has also been violated. MPEP §707.07(f) indicates that a proper Action is to take note of the points raised in traversing such a repeated rejection and answer the substance thereof.

Furthermore, Applicant respectfully submits that the PTO should clearly indicate the basis for a rejection. MPEP §707.07(d) states “[w]here a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated.” Furthermore, MPEP §706.02(j) states “[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims.” Thus, in any future rejection, Applicant respectfully requests that the PTO individually address the subject matter of each of the claims.

Consequently, in light of the above discussion and in view of the present amendment, the present application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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